



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

32860-000703/US

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Application Number

10/785,198

Filed

February 25, 2004

First Named Inventor

Thomas BIRKHOELZER et al.

Art Unit

2131

Examiner

Hoang, Daniel L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

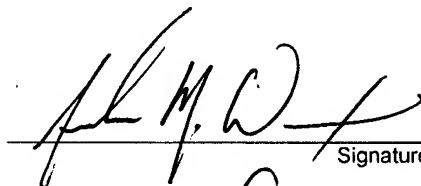
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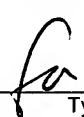
☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 34,313.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

 #56,007
Signature


Donald J. Daley
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Telephone number

September 6, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Thomas BIRKHOELZER et al. Group: 2136
Appl. No.: 10/785,198 Conf.: 3374
Filed: February 25, 2004 Examiner: Hoang, Daniel L.
Atty. Dkt No.: 32860-000703/US
For: METHOD FOR SIGNING DATA

**REASONS SUPPORTING REQUEST FOR PRE-APPEAL BRIEF
CONFERENCE**

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September 6, 2007

Sir:

Further to the concurrent filing of a Notice of Appeal, the following remarks are submitted in support of Appellant's Request for Pre-Appeal Brief Conference.¹ Claims 1-36 are pending. Of those, claims 1, 9 and 29 are independent.

REJECTIONS FOR WHICH PRE-APPEAL BRIEF REVIEW IS REQUESTED

Claims 1-36 stand rejected under 35 USC §102(b) as allegedly being anticipated by U.S. Patent No. 6,213,391 ("*Lewis*"). This rejection is respectfully traversed.

¹ Off. Gaz. Patent & Trademark Office, Vol. 1296, No. 2, July 12, 2005.

Response to Examiner's Rebuttal set forth in the July 5, 2007 Advisory Action.

The Examiner rebuts Appellants' arguments stating:

Examiner maintains the original reply to [Appellants' previous] argument in the previous office action. Further, at col. 6, lines 49-59, Lewis cites that, "alternatively, the account may be assigned a plurality of PIN codes, any of which may be authorize access." This further clarifies that a single PIN code grants [access] is capable of granting access and since it was argued before that more than one user can have access to the account, it is clear that in the case that only one PIN code is present, said more than one user would have to utilize the same code.²

Appellants disagree with this statement by the Examiner. Column 6, lines 49-59 of *Lewis* states:

Alternatively, the account may be assigned a plurality of PIN codes, any of which may authorize access. The smart card may store the algorithms which produce these PIN codes from an authorized user's unique identification value. Each time the account is accessed, the access code generator uses a different, randomly chosen stored algorithm, to produce one of the acceptable account access codes. In this manner, the account may be further protected because a chance interception of one access code will not automatically grant authorization, since the same access code is never allowed twice in a row.

Although each account may arguably be assigned a plurality of PIN codes, these PIN codes are not assignable to a plurality of users. The PIN codes are randomly produced from an authorized user's unique identification value using algorithms stored in the smart card, and thus, the same access code is never produced twice in a row. Because the PIN codes are randomly generated, the PIN codes in *Lewis* are not actually assigned to any user, let alone a

² Advisory Action, U.S. Pat. & Trademark Office, cont. sheet. (July 5, 2007).

plurality of users. Moreover, in *Lewis* each user's unique identification value, based on which the PIN codes are randomly generated, is unique to each user, and thus, assigned to only a single user.

Response to Examiner's Rebuttal set forth in the March 8, 2007 Final Office Action.

The Examiner also rebuts Appellants arguments stating in part:

Lewis teaches that once authorization has been established, the users' identification value may be converted into one or more access codes that may be used to provide access. Lewis teaches that these access codes may be used to access group accounts. This allows for the possibility of more than one user having access to the same account. Thus, Examiner concludes that since more than one user may be assigned to a single account, the access code pertaining to that account is assignable to a plurality of users.³

Appellants also disagree with this statement by the Examiner. The mere fact that *Lewis* allows for, "the possibility of more than one user having access to the same account," does not indicate nor suggest that the same access code is assigned or assignable to a plurality of users as would be the case assuming *arguendo* that *Lewis*' access code was the same as the "role signature," of claim 1. As previously argued, assigning the same access code to multiple users to access the same account would actually decrease security of the group accounts in *Lewis*, and thus, be in direct contrast to the purpose of *Lewis*,⁴ thereby leading one to conclude that the same access code is not assigned or assignable to a plurality of users in *Lewis*. Such a contrast with the purpose of

³ Final Office Action, U.S. Pat. & Trademark Office, p. 2 (March 8, 2007).

Lewis also leads one of ordinary skill in the art away from assigning the same access code to a plurality of users. Thus, *Lewis* actually teaches away from claim 1.

Moreover, the Examiner's understanding of *Lewis* is incorrect. *Lewis* does not teach that access codes are assignable to multiple users. To the contrary, group accounts are assigned to multiple users. That is, in *Lewis* a digital representation of a user's identification value is converted into one or more access codes, which provide access to one of a plurality of secure accounts.⁵ This allows for the existence of individually secure accounts on a user card, or in other words, the ability of a user to access multiple accounts using the same card. The cited portion of *Lewis* does not teach or suggest that the same access code is assigned to multiple users.

For at least the foregoing reasons, *Lewis*' access code does not constitute the "role signature," claim 1 because the access codes in *Lewis* are not "assignable to a plurality of users," as required by claim 1. Thus, Appellants respectfully submit claim 1 is patentable over *Lewis*. Claims 9 and 29 are also allowable over *Lewis* for at least reasons somewhat similar set forth above with regard to claim 1. Claims 2-8, 10-15, 17-28 and 30-36 are in condition for allowance at least by virtue of their dependency from independent claims 1, 9 or 29.

⁴ See, e.g., *Lewis* at 3:37-3:39 ("It is an object of the present invention to provide an accurate electronic personal identification system which offers improved security...")

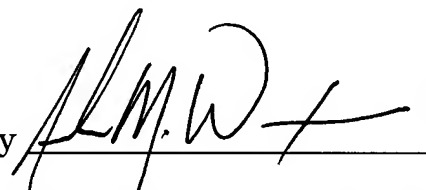
⁵ See, e.g., *Lewis* at 4:13-4:17.

CONCLUSION

In view of the above remarks, withdrawal of the above-noted rejections and Allowance of the pending claims is requested. If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

By

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